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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,907	10/13/2005	Leslie Donald Selsdon	GJ-268J	6962
7590 Iandiorio & Teska 260 Bear Hill Road Waltham, MA 02154		05/07/2007		
EXAMINER UPTON, CHRISTOPHER				
ART UNIT		PAPER NUMBER		
1724				
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05/07/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/552,907

Applicant(s)

SELSDON, LESLIE DONALD

Examiner

Christopher Upton

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Claims 3 and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 depends from claim 2, and claims 5-7 depend from claim 4, which have been canceled.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7, 9, 10 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanson.

Swanson discloses a filter having a material comprising particulate activated carbon (the carbon impregnated paper element 31) with separate retaining/supporting materials (yarn layers 27 and 37), as claimed.

4. Claims 3, 5, 6, 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson.

Claim 3 differs from Swanson in recitation of the particle size. It is submitted that this would have been an obvious matter of optimization for one skilled in the art, as Swanson discloses powdered carbon, absent a declaration showing unexpected results.

Claims 5, 6, 8 and 18 differ from Swanson in recitation of the retainer material. It is submitted that, as applicant discloses that these materials are known, it would have been obvious to substitute these materials for the polyester or polypropylene yarns of Swanson, absent a declaration showing unexpected results.

5. Claims 1, 7, 9, 10, 12-14, 16-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Brownawell.

Brownawell discloses a filter having an active media (14) which may comprise particulate activated carbon (see column 4, lines 20-26), which is retained between separate supporting/retaining layers formed by a non-active filter material (12) and a screen (10), as claimed.

6. Claims 3, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell.

Claim 3 differs from Brownawell in recitation of the particle size. It is submitted that this would have been an obvious matter of optimization for one skilled in the art, absent a declaration showing unexpected results.

Claims 5, 6 and 8 differ from Brownawell in recitation of the retainer material. It is submitted that, as applicant discloses that these materials are known, it would have been obvious to substitute these materials for the inactive filter of Swanson, absent a declaration showing unexpected results, as Brownawell discloses that a variety of materials may be used (see column 4, lines 34-38).

7. Claims 1, 7, 9, 10-14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer or Giampalmi Jr.

Bauer and Giampalmi disclose filters comprising particulate activated carbon retained by a paper media and additionally supported by perforated casings and screens, as claimed.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer or Giampalmi.

Claim 3 differs from Bauer or Giampalmi in recitation of the particle size. It is submitted that this would have been an obvious matter of optimization for one skilled in the art, absent a declaration showing unexpected results.

9. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson or Brownawell in view of Semar.

Claims 19 and 20 differ from Swanson and Brownawell in recitation of a non-return valve. Since it is well known to provide such valves in oil systems, as exemplified by Semar, it is submitted that addition of such a valve to the filters of

Swanson and Brownawell would have been obvious for one skilled in the art, to prevent backflow.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson, Bauer or Giampalmi in view of Brownawell.

Claim 21 differs from Swanson, Bauer and Giampalmi in recitation of a threaded outlet. It is submitted that, since threaded outlets are well known, as exemplified by Brownawell, the use of such an outlet in the devices of Swanson, Bauer and Giampalmi would have been obvious for one skilled in the art, depending on the system that the filter is to be used in.

11. Applicant's arguments filed on March 8, 2007 have been fully considered but they are not persuasive.

Applicant argues that the carbon of Swanson is impregnated in the cellulose pare, and is therefore not separate from the retaining material. It is submitted that, in addition to the paper, Swanson also includes two other retaining and supporting layers, formed by yarn layers 27 and 37. Therefore, the carbon impregnated paper of Swanson forms a filter comprising particulate activated carbon that is separate from the retaining and supporting yarn layers, as claimed. Note that claims 15 and 17 include recitations that the filter is in sheet form, which would include a paper impregnated with carbon particles, as disclosed by Swanson.

With respect to claim 3, applicant argues that the specific carbon size avoids dust problems. It is submitted that activated carbon is well known to come in a variety of

sizes, and that the specific size selection would obviously depend on a variety of factors, and therefore fails to patentably distinguish over a general teaching of particulate activated carbon, absent a declaration showing unexpected results.

With respect to claims 5, 6, 8 and 18, applicant argues that the paper of Swanson must be able to be impregnated by the carbon, and that therefore the use of the alternative materials is not a straightforward substitution. It is submitted that when the retainer is considered to be the yarn of Swanson instead of the paper, the substitution would have been straightforward, absent a declaration showing unexpected results for the specific materials, as the yarn is disclosed as being able to be made of a variety of polymeric materials.

12. Applicant's arguments with respect to claims 1, 3, 5-10, 12-14 and 16-21 have been considered but are moot in view of the new ground(s) of rejection.

Brownawell, Bauer and Giampalmi each disclose filters comprising particulate activated carbon between separate retaining and supporting layers, as recited in the claims.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Upton whose telephone number is 571-272-1169. The examiner can normally be reached on 7:30-5:00, off every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, consisting of a large 'C' followed by a stylized 'U' and a horizontal line.

Christopher Upton  
Primary Examiner  
Art Unit 1724